

#121

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

FRIEDRICH et al.

Serial No. 09/235,242

Filed: January 22, 1999

For: PREPARATION OF γ -ALKOXYNITRILES



Art Unit: 1613

Examiner: STOCKTON, L

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

PRELIMINARY STATEMENT

Claims 2 to 6 are in this application upon entry of the amendments filed under 35 U.S.C. 1.116.

The examiner is requested to favorably reconsider the rejection of claims 2-6 under 35 U.S.C. 112, second paragraph in view of the foregoing amendments. The title has been changed to "PREPARATION OF γ -ALKOXYNITRILES" rather than "PREPARATION OF β -ALKOXYNITRILES". Claims 2 to 5 depend from independent claim 6. It is now clear that the substituents R^1 to R^4 are descriptive of the diazabicycloalkene nucleus.

The examiner is requested to favorably reconsider the rejection of claims 2-6 under 35 U.S.C. 103(a) in view of the foregoing amendments and the following remarks. It's unfortunate that the prosecution of the parent application was focused on a process

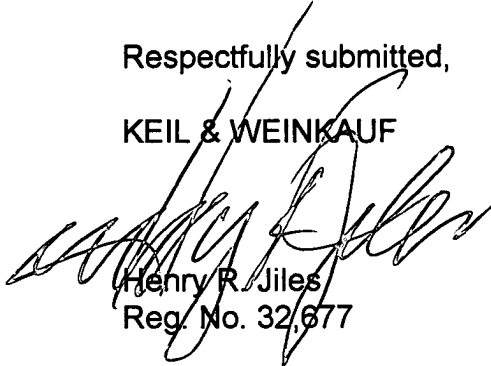
for preparing beta-alkoxynitriles and was therefore misplaced. Original claim 6 was directed to a process for preparing γ -alkoxynitriles and is now the base claim upon which the remaining claims are dependent. The examiner's rejection which relies upon prior art which relates to the preparation of β -alkoxynitriles is inapt. Favorable reconsideration is solicited.

In view of the foregoing amendments and remarks, the applicants respectfully urge that the invention claimed herein is patentable and a Notice of Allowance is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



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November 9, 1999

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First Named Inventor

Wolfgang FRIEDRICH

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This is a request for a ☒ continuation or ☐ divisional application under 37 CFR 1.53(d).(continued prosecution application (CPA)) of prior application number 09 / 235,242filed on 1/22/99, entitled PREPARATION OF B-ALKOXYNITRILES**NOTES**

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b) and filed on or after June 8, 1995, or (2) the national stage of an international application in compliance with 35 U.S.C. 371 and filed on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.



ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

- ☒ Enter the unentered amendment previously filed on 9/29/99 and suppl. amend 10/12/99 under 37 CFR 1.116 in the prior nonprovisional application.
- ☒ A preliminary amendment is enclosed.
- This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53 (d)(4).
 - ☐ DELETE the following inventor(s) named in the prior nonprovisional application:
- ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
- ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
- Information Disclosure Statement (IDS) is enclosed:
 - ☐ PTO-1449
 - ☐ Copies of IDS Citations

[Page 1 of 2]

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS (37 CFR 1.16(c))	5	-20 =		x \$ _____ =	\$ _____
INDEPENDENT CLAIMS (37 CFR 1.16(b))	1	-3 =		x \$ _____ =	\$ _____
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))				+ \$ _____ =	\$ _____
				BASIC FEE (37 CFR 1.16(e))	760.
				Total of above Calculations =	760.
Reduction by 50% for filing by small entity (Note 37 CFR 1.9, 1.27, 1.28).					
TOTAL =					

6. Small entity status:

- a. ☐ A small entity statement is enclosed.
b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
c. ☐ Is no longer claimed.

7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 11 - 0345:

- a. ☒ Fees required under 37 CFR 1.16.
b. ☒ Fees required under 37 CFR 1.17.
c. ☐ Fees required under 37 CFR 1.18.

8. ☒ A check in the amount of \$ 760.00 is enclosed.

9. ☐ Other: _____

NOTE:

The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

10. NEW CORRESPONDENCE ADDRESS

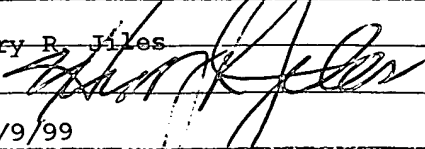
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11. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME	Henry R. Jiles
SIGNATURE	
DATE	11/9/99